Attorney's Docket No. 42390.P8085   PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:

Silvester

Application No.: 09/470,669

Filed: 12/23/1999

For: NOTEBOOK COMPUTER WITH
       INDEPENDENTLY FUNCTIONAL,
       DOCKABLE CORE COMPUTER

Examiner: Vu, Trisha U.

Art Unit: 2112

02/01/2005 HDEHESS1 00000072 09470669
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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPEAL BRIEF
IN SUPPORT OF APPELLANTS' APPEAL
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Dear Sir:

The Appellants hereby submit this Brief in support of their appeal from a

final decision by the Examiner, mailed August 24, 2004, in the above-captioned

case. The Appellants respectfully request consideration of this appeal by the

Board of Patent Appeals and Interferences for allowance of the above-captioned

patent application.

FIRST CLASS CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on _____ January 26, 2005 _____
                                                            Date of Deposit

_____ Patricia Richard _____
Name of Person Mailing Correspondence

_____   January 26, 2005 _____
           Signature   Date

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I. REAL PARTY IN INTEREST

The real party in interest is Intel Corporation, a corporation of Delaware having a principle place of business at 2200 Mission College Blvd., Santa Clara, CA 95052.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF THE CLAIMS

In this application, claims 1-5, 7-12, and 14-20 are pending.

Examiner rejected claims 1-5, 7-9, 12, 14, and 17-19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,999,997 (hereinafter "Pipes") in view of U.S. Patent 6,128,661 (hereinafter "Flanagin).

Examiner rejected claims 10, 11, 15, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Pipes in view of Flanagin, and further in view of U.S. Patent 5,884,049 (hereinafter "Atkinson").

Examiner rejected claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Pipes in view of Flanagin as applied to claim 12, and further in view of U.S. Patent 5,754,798 (hereinafter "Uehara").

IV. STATUS OF AMENDMENTS

A final office action was mailed August 24, 2004 rejecting claims 1-5, 7-12, and 14-20 for the reasons specified above. A Notice of Appeal was filed January 24, 2005.

The claims found in the Appendix of this Appeal Brief reflect the claims as they are understood by the Applicant to stand at the date of this appeal.

V. SUMMARY OF THE INVENTION

In accordance with an embodiment of the present invention, a notebook computer includes a docking port (or bay) to receive a core computer. The processor of the core computer serves as the system processor for the notebook computer when the core computer is docked in the notebook computer. When the core computer is undocked, the processor serves as the system processor for the core computer. The core computer includes memory containing a mini operating system to be booted when undocked, and the notebook computer includes memory containing a full operating system to be booted when the core computer is docked. When the core computer is docked, the notebook computer memory is synchronized with the core computer memory, a battery in the core computer is charged, and the processor runs at a higher frequency and higher voltage than when the core computer is undocked.

VI. ISSUES

In the Final Office Action mailed August 24, 2004, the Examiner has:

(1) continued a rejection under Section 103 of Claim(s) of claims 1-5, 7-9, 12, 14, and 17-19 based on Pipes in view of Flanagin.

(2) continued a rejection under Section 103 of Claim(s) of claims 10, 11,

15, and 20 based on Pipes in view of Flanagin, and further in view

of Atkinson.

(3) continued a rejection under Section 103 of Claim(s) of claim 16 based

on Pipes in view of Flanagin as applied to claim 12, and further in

view of Uehara.

The question presented on this Appeal is:

(1)   Whether the combination of Pipes in view of Flanagin renders the

claimed invention obvious?

VII.   GROUPING OF CLAIMS

All claims are grouped together.

VIII.   ARGUMENT; REJECTION OF THE PRESENT INVENTION IS IMPROPER SINCE ONE SKILLED IN THE ART WITH KNOWLEDGE OF THE PRIOR ART WOULD NOT HAVE USED THE PRIOR ART TO COME UP WITH THE INVENTION AS CLAIMED

Question 1 -- Whether the combination of Pipes in view of Flanagin renders

the claimed invention obvious?

THE PRESENT CLAIMS INCLUDE LIMITATIONS NOT
DISCLOSED IN EITHER PIPES NOR FLANAGIN

TO MODIFY PIPES WOULD DESTROY THE INTENDED
PURPOSE OF PIPES

To establish *prima facie* obviousness of a claimed invention,
all the claim limitations must be taught or suggested by the prior
art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).
(Manual of Patent Examining Procedure (MPEP) ¶ 2143.03).

Applicant's independent claims 1, 12, and 17, include limitations that are

not disclosed nor suggested by the Pipes or Flanagin references. As a result,

Applicant's independent claims are patentable over the Pipes and Flanagin references.

In particular, Applicant's independent claims 1, 12, and 17, include the limitation, or a limitation similar thereto, <u>of a housing to have an electronic device docked into a notebook computer</u>. Pipes, however, only **teaches** docking a portable computer into a <u>server</u>, rather than a notebook computer, as is claimed by applicant.

The Examiner states that one of ordinary skill in the art would have been motivated to replace the desktop disclosed in Pipes with a notebook computer because a notebook computer is more portable. However, to do so would destroy the intended function of Pipes.

> If proposed modifications of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti,* 270 Fed. 2d 810, 123 USPQ 349. (MPEP §2143.01).

The principle operation of Pipes is to provide a server that is able to dock a portable computer, so that the server would not have to have peripherals such a keyboard etc. Rather, a user could use the peripheral provided by the docked notebook and the processing power of the server docking the notebook.

> Among the advantages of the invention are one or more of the following. A dedicated keyboard, mouse or display does not have to be purchased for the server. One portable computer may provide a keyboard, monitor, or mouse for any of several servers. (Col. 2, lines 7-11.)

As shown in FIGS. 1A and 1B, unlike a portable computer 200, a file server 100 does not typically require input/output (I/O) devices 230-232 (a monitor 231, a keyboard 230, and a mouse 232) that are typically part of the portable computer 200 because the server 100 normally does its work without the need for direct intervention between the server and the user. In the invention, when I/O devices are needed by the server 100, they can be provided from the portable computer 200 by docking it (mechanically and electrically connecting it) to the server 100. Once docked, the portable computer 200 may operate in a run time mode which permits the server 100 to access and directly use the I/O devices 230-232 as if the I/O devices 230-232 were part of the server 100.

Thus, additional I/O devices do not have to be purchased specifically for the server 100, reducing cost. When not docked to the server 100, the portable computer 200 may be used as a workstation of a Local Area Network (LAN) or a Wide Area Network (WAN) serviced by the server 100 or as a stand-alone portable computer. (Col. 2, lines 35-55.)

Therefore, to modify the server of Pipes to be a notebook computer, as claimed by applicant, would change the principle operation of Pipes to provide a server computer not having to have a variety of peripherals.

Although Pipes does fortuitously mention the conflicting statement that the first computer may be a portable computer, the statement is conflicting with the overwhelming primary teachings of Pipes (to have the first computer be a server to dock a separate portable computer.) The test of obviousness is what the teaching of the reference would have suggested to one skilled in the art, and where there are conflicting teachings the examiner is to weight the power of each when considering the teachings to one skilled in the art. (*In re Young*, 927 F.2d 588, 18 USPQ 2d 1089 (Fed. Cir. 1991)).

As a result, applicant's independent claims are patentable over Pipes in view of Flanagin. Moreover, applicant's remaining claims depend from at least one of the independent claims, as discussed above, and therefore also include the distinguishing limitation of the respective independent claim. The dependent claims are therefore also patentable over Pipes in view of Flanagin.

IX. CONCLUSION

For all of the foregoing reasons, this Board is respectfully requested to remand this application to the Examiner for reconsideration consistent with an order that the Examiner pass this case to issuance unless a proper rejection to the claims can be made.

FEE FOR FILING A BRIEF IN SUPPORT OF APPEAL

Enclosed is a check in the amount of $500.00 to cover the fee for filing of a brief in support of an appeal required under 37 C.F.R. 1.17(f) and 1.192.

CHARGE OUR DEPOSIT ACCOUNT

Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 1/26/05

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Appendix A

1.   (Previously Presented) An electronic device comprising:

a housing to have the device docked into a notebook computer having a

memory to store a first operating system;

an interface disposed on a surface of the housing to enable

communication between the device and the notebook computer when the device

is docked;

a memory to store a second operating system, the second operating

system is smaller in size and provides less functionality than the first operating

system ; and

a central processing unit (CPU) to operate as a system processor of the

notebook computer when the device is docked and to operate as a system CPU

of the device when the device is undocked.

2.   (Original) The electronic device of claim 1, further comprising an input

controller to receive input data into the device when the device is undocked.

3.   (Original) The electronic device of claim 2, further comprising core

memory to store the input data when the device is undocked.

4.   (Original) The electronic device of claim 3, further comprising an output

controller to provide output data from the device when the device is undocked.

5.　　(Original) The electronic device of claim 4, further comprising a visual display disposed on a surface of the housing, the visual display being coupled to the input controller to provide the input data via pen-based entries on the display and being coupled to the output controller to provide the output data via the display.

6.　　(Cancelled)

7.　　(Previously Presented) The electronic device of claim 1, further comprising a battery to provide power to the CPU when the electronic device is undocked.

8.　　(Original) The electronic device of claim 7, wherein the interface is coupled to the battery to charge the battery when the electronic device is docked.

9.　　(Previously Presented) The electronic device of claim 8, wherein the notebook computer is to provide power to the CPU when the electronic device is docked.

10.　　(Previously Presented) The electronic device of claim 9, wherein the CPU is to operate at a higher frequency and at a higher voltage when the device is docked than when the device is undocked.

11. (Previously Presented) The electronic device of claim 1, wherein the CPU is to operate at a higher frequency and at a higher voltage when the device is docked than when the device is undocked.

12. (Previously Presented) A notebook computer comprising:

a docking port to receive a hand-held core computer having a Central Processing Unit (CPU) to operate as a system CPU of the notebook computer when the device is docked, and to operate as a system CPU of the core computer when the core computer is undocked, the hand-held core including a memory to store a first operating system;

an interface in the docking port to enable communication between the core computer and the notebook computer when the core computer is docked; and

a memory to store a second operating system, the second operating system is larger in size and has greater functionality than the first operating system.

13. (Cancelled)

14. (Previously Presented) The notebook computer of claim 12, wherein the interface is to couple a power supply of the base computer to a battery in the core computer to charge the battery and to provide power to the CPU when the core computer is docked.

15. (Previously Presented) The notebook computer of claim 14, wherein the CPU is to operate at a higher frequency and at a higher voltage when the CPU

operates as a system CPU of the notebook computer than when the CPU

operates as a system CPU of the core computer.

16.   (Previously Presented) The notebook computer of claim 12, wherein the

CPU is to operate in one of a high power mode and a low power mode according

to user preference.

17.   (Previously Presented) A method of operating a computer system

comprising:

        operating a Central Processing Unit (CPU) as a system CPU of a

notebook computer when a core computer is docked in a docking port of the

notebook computer, the notebook computer including a memory to store a first

operating system; and
        operating the CPU as a system CPU of the core computer when the core

computer is undocked, the core computer including a memory to store a second

operating system , the second operating system is smaller in size and provides

less functionality than the first operating system.

18.   (Original) The method of claim 17, further comprising synchronizing

memory of the notebook computer with memory of the core computer when the

core computer is docked.

19.   (Original) The method of claim 17, further comprising charging a battery in

the core computer when the core computer is docked.

20. (Previously Presented) The method of claim 17, wherein operating the CPU as a system CPU of the notebook computer includes operating the CPU at a higher frequency and voltage than when operating the CPU as a system CPU of the core computer.

21. (Cancelled)